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REMARKS

**Points 1 and 2
Office Action Incorrect**

Point 1

Applicants respectfully submit that the Office Action is factually incorrect.

Background

Applicants set forth the following Background:

-- Applicants submitted an Amendment under Certificate of Mailing dated May 30, 2003, and called "Amendment A" herein.

-- An Office Action (mailed 8/27/2003, and called "First Assertion of Non-Response" herein) asserts that the Amendment A was non-responsive to a previous Office Action, because the Amendment A failed to

- 1) point out why added claims 8 - 13 were patentable and
- 2) show why claims 2 - 5 and 7 were patentable over the references.¹

¹ Applicants point out that the claims in question (2 - 5, 7, and 8 - 13) are all dependent claims. There is no requirement that Applicants argue the patentability of dependent claims. Arguing the patentability of the parent claims, which was done, is sufficient.

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-- In response to the First Assertion of Non-Response, Applicants submitted a Corrected Amendment, under Certificate of Mailing dated September 29, 2003.

-- In response to the Corrected Amendment, the PTO issued another Office Action (mailed 12/29/2003, called "Second Assertion of Non-Response" herein, and which is the Office Action to which this Request responds), which asserts that Applicants' Corrected Amendment is not fully responsive.

To repeat:

- 1) Applicants filed an Amendment A.
- 2) The PTO asserted the Amendment A to be non-responsive.
- 3) Applicants filed a Corrected Amendment, which corrected the supposed defects.
- 4) The PTO now asserts that the Corrected Amendment is non-responsive, because it contains **new** defects.

From another perspective, it is axiomatic that, if a parent claim is allowable, its dependent claims are also allowable.

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Discussion

The supposed defect in the Corrected Amendment was never previously identified by the PTO. That is, as stated above, the alleged defect in Amendment A is that it failed to

- 1) point out why added claims 8 - 13 were patentable and
- 2) show why claims 2 - 5 and 7 were patentable over the references.²

The Corrected Amendment removed those alleged defects.

THEREFORE, Applicants submit that the Second Assertion of Non-Response is factually incorrect: the Corrected Amendment fully addressed the two supposed problems in Amendment A.

The Corrected Amendment cannot be defective for failing to address issues not mentioned in the First Assertion of Non-Compliance.

Thus, since it appears that the Corrected Amendment corrected all defects identified at the time it was filed, Applicants request that the PTO identify the specific sections of any Office Action to which Applicants must respond, and to which response is

² Applicants point out that the claims in question (2 - 5, 7, and 8 - 13) are all dependent claims. There is no requirement that Applicants argue the patentability of dependent claims. Arguing the patentability of the parent claims, which was done, is sufficient.

From another perspective, it is axiomatic that, if a parent claim is allowable, its dependent claims are also allowable.

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lacking.

Point 2

Background

The current Office Action (ie, Second Assertion of Non-Response) asserts that claim 7 is not clear, because it contains the terms "unit D," "unit E," and "unit F." A similar assertion was made with respect to claim 6. The Office Action requests clarification.

Discussion

The asserted lack of clarity is not an indication that the Corrected Amendment is non-responsive. Thus, the current Office Action is factually incorrect.

Restated, the current Office Action is making a new assertion of a defect in two claims, not previously made.

That is piecemeal examination, which is specifically prohibited by the MPEP.

*which
gen?* Further, the undersigned attorney is unaware of any statute or regulation which requires Applicants to submit a clarification of a claim. Applicants thus request a citation of authority in support of the request for clarification.

If the PTO believes that claims 6 and 7 have defects under section 112, then the PTO should issue a rejection under that code

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section.

Point 3
Standard Terminology Being Used

Claim 6 states, in part:

- A) copies of a software unit A is contained in every PAK_MOD module;
- B) some PAK_MOD modules contain a software unit B with no unit C; and
- C) some PAK_MOD modules contain a software unit C with no unit B.

As stated above, the PTO finds fault in the terms "unit A," "unit B," etc. However, those terms are nothing more than **labels** for different software modules.

The terms in question (eg, "unit D") are, in essence, no different than similar terms which are clearly acceptable, such as "first unit," "second unit," and so on. Specifically, as to claim 7:

"Unit D" could be replaced by
"fourth unit,"
"Unit E" could be replaced by "fifth
unit," and
"Unit F" could be replaced by "sixth
unit,"

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with no change in meaning.

Similarly, as to claim 6,

"Unit A" could be replaced by "first unit,"

"Unit B" could be replaced by "second unit," and

"Unit C" could be replaced by "third unit."

The terms "first unit," "second unit," etc. represent standard claim terminology. For example, claim 1 in US patent 6,671,883 (Rahman, SN 09/461,934, Dec. 30, 2003) states:

A method for implementing communication between a settop box and a target network through **a second head end**, comprising:

detecting, at a **first head end**, when a connectivity between the settop box and the target network through **the first head end** is lost;

initiating a call over a wireless communication link from **the first head end** to **the second head end** when a lost connectivity is detected at **the first head end**; and

completing a connection between **the second head end** and the settop box to implement communication between the settop box and the target network.

Plainly, "first head end" could be replaced by "head end A." "Second head end" could be replaced by "head end B." No change in

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meaning would occur.

Therefore, "unit A" is fundamentally no different than "first unit." This applies to all the recited "units."

Applicants offer to amend the claims to recite "first units," "second units," etc. if the PTO requests.

Point 4

**Claim 6 is Reciting Specific Combinations of DIFFERENT Elements,
But is not Required to Specify Content of Each Element**

Applicants respectfully submit that the PTO appears to be asking the wrong question. The PTO appears to be asking something like "What is a 'unit A' ?"

However, that is not the point of claim 6. This passage of claim 6 is stating, for example, that two types of PAK_MOD modules are present:

- 1) those which contain unit A and unit B, but no unit C;
- 2) those which contain unit A and unit C, but no unit B.³

Support for this is found in the Specification, particularly in the last three paragraphs prior to the Claims (page 33), and more generally on pages 31 - 33..

The claim language in question is using **labels** to recite

³ Paragraph (A) in the passage states that every PAK_MOD contains unit A.

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specific combinations of elements.

Points 5 - 8
Support in Specification

Point 5

Applicants point out that page 33 of the Specification states:

In another embodiment, an inventory of software modules is maintained, which includes

(1) a group of type A modules;

and

(2) a collection of type B modules.

When constructing each software system, a practitioner (1) includes copies of the entire group of type A modules; and (2) includes copies of selected type B modules in the system.

In addition, the practitioner generates at least one customized module, which is a copy of neither a type A nor a type B module, and includes that within the system.

This language corresponds directly with that of claims 6 and 7. Additional support is found on pages 31 - 33.

Point 6

The passage of the Specification just cited refers to an "inventory of software modules" "which includes" "type A modules"

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and "type B modules."

Claim 6 recites "software unit A," "software unit B," and "software unit C."

Applicant requests that the PTO explain why "software unit A" in claim 6 is not supported by the phrase "inventory of software modules" "which includes" "type A modules" which appears on page 33 of the Specification.

Point 7

Applicant points out that MPEP 2163.02, near the end, states:

. . . the fundamental factual inquiry is whether a claim defines an invention that is **clearly conveyed** to those skilled in the art at the time the application was filed.

The subject matter of the claim **need not be described literally** (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

This MPEP section continues to state:

Any time an examiner bases a rejection of a claim . . . on the lack of a written description, the examiner should:

(A) identify the claim limitation not described; and

(B) provide reasons why persons skilled in the art at the time the application was filed would not have recognized the description of this limitation in the disclosure of the

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application as filed.

Point 8

Applicants point out that, under section 112 (ie, 35 USC § 112), the claims are **part of** the Specification.

MPEP § 2163.06(c) states:

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.

Applicant offers to make such an amendment under this MPEP section, if the PTO so requests.

Respectfully submitted,



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